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OFFICE OF PETITIONS

In re Application of :
Karen Young :
Application No. 10/815,480 : ON APPLICATION FOR
Filed: March 31, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No.022101-000230US:

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. §1.705(b) filed January 6, 2009. Applicant requests that the determination of patent term adjustment be corrected from thirty-six (36) days to, at minimum, nine hundred thirteen (913) days, with an additional term to be added if the patent issues after April 21, 2009. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent

within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

To the extent that applicant otherwise requests correction of the initial determination of patent term adjustment at the time of mailing of the notice of allowance, the application for patent term adjustment is **DISMISSED**.

On October 9, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 36 days. The instant application for patent term adjustment was timely filed¹ on or before payment of the issue fee. In effect, applicant disputes the period of adjustment of 104 days entered pursuant to 37 CFR §§1.702(a)(1) and 1.703(a)(1) for Office delay in taking until September 12, 2005 to mail the first Office action (14 months and 104 days after the actual filing date of the application, March 31, 2004). Applicant states that the period of adjustment is 252 days computed based on the mailing of the 1st restriction requirement on February 7, 2006, as this restriction requirement states on page 2 that it replaces the previous restriction requirement.

¹ PALM records indicate that the issue fee was paid on January 6, 2009.

Applicant further states that the patent issuing from the application is not subject to a terminal disclaimer.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 154(b)(1)(A)(i) provides that:

— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after—

(I) the date on which an application was filed under section 111(a) of this title; or

(II) the date on which an international application fulfilled the requirements of section 371 of this title;

37 CFR § 1.702 provides that:

(a) Failure to take certain actions within specified time frames . Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

37 CFR § 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the

date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

OPINION

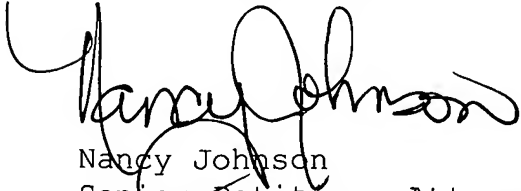
Applicant's arguments and evidence have been considered, in light of the application history, and it has been determined that the period of adjustment of 104 days for Office delay pursuant to 37 CFR 1.702(a)(1) is correct. It is undisputed that the Office mailed an action under 35 U.S.C. 132, a restriction requirement, on September 12, 2005, fourteen months and 104 days after the actual filing date of this application. The subsequent mailing of another Office action under 132 does not alter the date used in calculation of the period of adjustment. Pursuant to 35 U.S.C. 154(b)(1)(A), applicant is only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after the first 14 months of pendency of the application before the Office, to the extent that the Office failed to make an objection or argument under 35 U.S.C. 132 until September 12, 2005. The fact that the Office later replaced the Office action does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(1) on September 12, 2005. Thus, it is correct for the Office to use the date of September 12, 2005 in calculating the period of adjustment due to the examination delay in initially acting on this application. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

In view thereof, the correct patent term adjustment at the mailing of the notice of allowance remains 36 days.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" written in a larger, more prominent script than the last name "Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions